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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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022249
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EXAMINER	
TUNG, M	
ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Response to Appellant's Reply to the Order to Show Cause

This is in response to appellant's Reply to the Order to Show Cause received January 8, 1999 (certificate of mailing January 4, 1999).

An Order to Show Cause and Remand to Examiner was mailed on December 1, 1998 from the Board of Patent Appeals and Interferences (Board). In that paper, appellant was ordered to show cause why the appeal in this application should not be dismissed for failure to address the additional grounds of rejection set forth in an advisory action mailed November 12, 1996, and the examiner was ordered to consider the adequacy of appellant's response to the order and take whatever action the examiner deems appropriate.

The examiner has considered appellant's response and deems it unpersuasive. In essence, appellant states that he was not aware that there was an advisory action of November 12, 1996 until he was involved in the task of preparing a response to the Board's Order to Show Cause. Appellant states that "[t]here was thought to have been nothing since the Final Rejection" mailed December 5, 1995, and that the issues in the Final Rejection were covered in the Appeal Brief. Appellant's explanation is not persuasive because subsequent to the Final Rejection (mailed December 5, 1995), appellant filed four "after final" amendments on February 27, 1996, July 26, 1996, August 19, 1996 (substitute second amendment), and September 5, 1996. Advisory actions were mailed on March 19, 1996 and November 12, 1996. In each of the after final amendments, appellant states that the amendment is offered to "reduce issues on Appeal" and is intended to "simply comply with the" examiner's requirements. Patent examining practice according to

section 714.13 of the Manual of Patent Examining Procedure requires examiners to notify the applicant immediately of the disposition of after final amendments. It is not convincing that while appellant's intent was to "simply comply" with requirements and "reduce issues" on appeal, appellant did not expect feedback from the USPTO. In fact, appellant's very own amendment filed September 5, 1996 necessitated the additional grounds of rejection.

Appellant's explanation that his case file did not contain the November 1996 advisory action in its chronological order is acknowledged, but is not an acceptable explanation sufficient now to permit entry of arguments and does not excuse appellant from addressing the issues in a timely manner. There is no dispute that appellant received the November 1996 advisory action and the February 1997 examiner's answer, both of which clearly set forth the rejection under 112, first paragraph.

Notwithstanding the November 1996 advisory action and the February 1997 examiner's answer, the rejection of the claim under 35 U.S.C. 112, first paragraph actually continues from the July 18, 1991 final rejection leading to the prior appeal, no.93-0363, mailed June 23, 1993, where the Board affirmed both the rejection of the claim under 35 U.S.C. 103 and 35 U.S.C. 112, first paragraph. Since the Board's reasons went beyond the examiner's position, the rejections were considered new grounds. Those rejections were made final in paper #30 mailed December 5, 1995, leading to the current appeal. The four successive amendments after final did not successfully overcome the rejection under 35 U.S.C. 112, first paragraph. Neither of the responsive Advisory Actions withdrew the rejection under 35 U.S.C. 112, first paragraph; in fact,

they both specifically sustained the rejection. The rejection under 112, first paragraph has been outstanding since July 1991.

Appellant's own numerous submissions and changes upon changes to drawings may have helped add to appellant's unintentional misunderstanding of the rejection under 112, first paragraph. For every feature changed correctly in the drawing, there would be a feature changed incorrectly which would require an objection or be considered new matter which would form the basis for a rejection under 112, first paragraph. Subsequently, that change may have been corrected, but then another change would prompt an objection or sustain a rejection. As shown in the record, at every stage of the application since the final rejection in 1991, the 112, first paragraph rejection existed.

Most importantly, appellant's substantive response to the rejection in the reply to the order to show cause does not even place the application in condition for allowance, or in better form for appeal. The response does not overcome the new matter issues, instead, sets forth written arguments which assert that the rejection is made erroneously by yet again comparing the original mechanical drawings to the approximately eighth set of new drawings. Either similar arguments have been made in earlier responses or new arguments are raised to address new changes prompted by appellant's newest set of drawings. The arguments merely echo the main dispute which has been at the heart of the application since its inception -- the shape of the flashlight head.

It is the examiner's position that appellant's response to the order to show cause is not persuasive and that the appeal should be dismissed for failure to address the additional grounds of rejection.

Respectfully submitted,

M. H. TUNG
PRIMARY EXAMINER
ART UNIT 2911

mht
July 25, 2001